

### **REMARKS**

Claims 1-4, 7, 10-19 and 21 remain pending in the present application. Claims 5, 6, 8, 9 and 20 have been cancelled. Claims 1, 14 and 21 have been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-4, 7-12, 14-18 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sawai (U.S. Pat. No. 6,511,085). Applicant respectfully traverses this rejection. Claim 1 has been amended to include the limitations of Claim 5. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawai in view of Handke, et al. (U.S. Pat. No. 4,328,960). Applicant respectfully traverses this rejection.

Previous Claim 5 and now amended Claim 1 define the piston rod as having a vent hole extending between the cavity in the piston rod and atmospheric pressure. The Examiner states that one of ordinary skill in the art would have modified the damping unit of Sawai by utilizing a damper as a single unit (without hydraulic fluid connection to the pressure regulator 86 as shown in Figure 2) with the chamber 162 venting out to the atmosphere since the damper (use as a single unit) can still function effectively by itself.

Applicant submits that this combination of Handke, et al. with Sawai and then venting chamber 162 to the atmosphere and using the damper as a single unit goes against the teachings of Sawai and it renders Sawai unsatisfactory for its intended purpose.

Sawai is directed to a system where two shock absorbers are connected together through pressure regulator 86. (See Abstract, column 1, lines 8-11 and the Summary of the Invention). Thus, the concept of utilizing only one damper and venting chamber 162 to the atmosphere destroys the inter-related relationship between dampers 82 and 84 and thus renders Sawai unsatisfactory for its intended purpose, the inter-relation of two dampers. If the purpose modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re *Gordon*, 733 F2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Thus, Applicant believes Claim 1, amended by adding the limitations of Claim 5, patentably distinguishes over the art of record. Likewise, Claims 2-4, 7 and 10-13, which ultimately depend from Claim 1, are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claim 14 has been amended to also include the limitations of Claim 5 and thus, the above discussion applied to Claim 14 also. Thus, Applicant believes Claim 14, as amended, patentably distinguishes over the art of record. Likewise, Claims 15-19, which ultimately depend from Claim 14, are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claims 5, 6, 8, 9 and 20 have been cancelled.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawai in view of Handke, et al. (U.S. Pat. No. 4,328,960). Claims 5 and 6 have been cancelled with the limitations of Claim 5 being added to Claims 1 and 14 as discussed above. Reconsideration of the rejection is respectfully requested.

Claims 13 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawai in view of Sugiura (U.S. Pat. No. 3,784,179). Claim 13 ultimately depends from Claim 1. Claim 19 ultimately depends from Claim 14. As stated above, Claims 1 and 14 have been amended and are now believed to patentably distinguish over the art of record. Thus, Claims 13 and 19 are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawai in view of Handke, et al. (U.S. Pat. No. 4,328,960). Claim 21 has been amended by adding the limitations of Claim 5 and thus the discussion above relating to Claim 5 applies here also. Thus, Applicant believes Claim 21, as amended, patentably distinguishes over the art of record. Reconsideration of the rejection is respectfully requested.

### **ENTRANCE OF AMENDMENT**

Applicant respectfully requests entry of this amendment after final. Applicant believes that this amendment merely cancels claims, removes issues for appeal and since the independent claims have been amended to include the limitations of a currently

pending claim that has been cancelled, this amendment should only require a cursory review by the Examiner.

### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: June 8, 2005

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